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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,932	08/02/2001	Bettina Moeckel	211707US0X	4629

22850 7590 01/05/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,932

Applicant(s)

MOECKEL ET AL.

Examiner

Richard G Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-74 is/are pending in the application.
- 4a) Of the above claim(s) 60-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41,44,47 and 56-59 is/are rejected.
- 7) ☒ Claim(s) 42,43,45,46 and 48-55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/03 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants cancellation of claims 1-40 and the addition of new claims 41-74 in the paper of 10/15/2003 is acknowledged. Claims 41-74 are at issue and are present for examination.

Applicants' arguments filed on 10/15/2003 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Applicants acknowledge that claims 60-74 are drawn to the same subject matter as those claims previously examined and further request the rejoinder of claims 60-74 upon the finding that the elected claims are found allowable (see MPEP 821.04). Applicants request for those claims subject to rejoinder is acknowledged, however this issue will be dealt with upon the determination that the elected claims are allowable.

Claims 60-74 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Priority***

As previously stated, applicants claim of priority to US Provisional Application No. 60/294,252, filed 5/31/2001 and German Application Nos. DE10043334.0, filed 9/2/2000, and DE 10109690.9, filed 2/28/2001, is acknowledged, however for this

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priority to be perfected a translation of the referred to german language documents is necessary.

### ***Information Disclosure Statement***

Applicants filing of information disclosures, Paper No. 9, filed 10/15/2003 is acknowledged. Those present and considered have been initialed.

### ***Claim Objections***

Claims 42, 43, 45, 46 and 48-55 are objected to because of the following informalities:

Claims 42, 43, 45, 46 and 48-55 are dependent on rejected claim 41.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41, 44, 47, 56, 58 and 59 are rejected under 35 U.S.C. 102(a) as being anticipated by Hwang et al. (Database EMBL, Accession No. AF220150, 2/5/2001).

The rejection was stated in the previous office action as it applied to previous claims 1, 2, 5 and 6 now cancelled. Claims 41, 44, 47, 56, 58 and 59 are drawn to the same subject matter as claims previous claims 1, 2, 5 and 6.

As previously stated , Hwang et al. teach the *Corynebacterium glutamicum* O-acetylhomoserine sulfhydrylase gene which comprises a polynucleotide sequence that has a best local similarity score of 99.9 % between nucleotide 8 and nucleotide 1677 of SEQ ID NO: 1 and encodes at least 15 successive nucleotides of a polynucleotide which is at least 70% identical to a polynucleotide that encodes the amino acid sequence of SEQ ID NO: 2. Hwang et al. further teaches vectors and host cells comprising the taught polynucleotide. Thus claims 41, 44, 47, 56, 58 and 59 are anticipated by Hwang et al.

In response to this previous rejection applicants traverse this rejection based on applicants claim of priority to German application 10043334.0 filed 9/2/2000. Applicants claim to priority is acknowledged, however it is noted that for this priority to be perfected a certified translation of the priority document must be supplied by applicant.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang et al. (Database EMBL, Accession No. AF220150, 2/5/2001).

The rejection was stated in the previous office action as it applied to previous claim 21 now cancelled. Claims 41, 44, 47, 56, 58 and 59 are drawn to the same subject matter as claims previous claim 21.

As discussed above, Hwang et al. teach the *Corynebacterium glutamicum* O-acetylhomoserine sulfhydrylase gene which comprises a polynucleotide sequence that has a best local similarity score of 99.9 % between nucleotide 8 and nucleotide 1677 of SEQ ID NO: 1 and encodes at least 15 successive nucleotides of a polynucleotide which is at least 70% identical to a polynucleotide that encodes the amino acid sequence of SEQ ID NO: 2.

One of ordinary skill in the art at the time of filing would have been motivated to express either of the polynucleotides taught by Hwang et al. in a *coryneform* bacterium so that the encoded proteins could be produced, in order to study the mechanism of actions of each of the identified enzymes involved in methionine biosynthesis in *Corynebacterium glutamicum*. The reasonable expectation of success comes from the high degree of knowledge in the art of heterologous in vitro protein expression.

In response to this previous rejection, as above, applicants traverse this rejection based on applicants claim of priority to German application 10043334.0 filed 9/2/2000. Applicants claim to priority is acknowledged, however it is noted that for this priority to be perfected a certified translation of the priority document must be supplied by applicant.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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A handwritten signature in black ink, appearing to read 'R. G. Hutson', with a long horizontal flourish extending to the right.

Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit 1652

rg  
12/16/2003